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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,538	11/09/2001	Takahiro Osumi	214330US0CONT	5771

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EXAMINER

TRAN, SUSAN T

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 05/05/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/986,538	Applicant(s) OSUMI ET AL.	
	Examiner Susan Tran	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of applicant's Changed of Address filed 12/23/02,
Request for Extension of Time and Amendment filed 02/12/03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Uemura et al. US 5,512,277.

Uemura teaches keratotic plug remover composition comprising combination of 2-acrylamide-2-methyl propane sulfonic acid polymer, and nonionic polymer, such as, polyethylene oxide, polyvinyl alcohol, hydroxyethylcellulose, or pullulan (column 2, tables 1-6, and examples). The amount of polymer is from 0.01 to 70%, and the nonionic polymer is about 5% (column 3, and examples), which if converted into ration would fall within the claimed ratio of 30:70 to 70:30. The polymers having molecular weight between 10,000 to 1,500,000 (column 3, lines 1-22). The composition further comprising pigment, e.g., talc, mica, zinc oxide, or titanium oxide; oil, such as, liquid/solid paraffin, squalane, or vaseline; and other agents, e.g., drugs, surfactants, polyethylene glycols, glycerols, ethylene glycol, or ethylene oxide (columns 4-5). The process of removing keratotic plugs is disclosed in the examples, and claim 18.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uemura et al.

Uemura is relied upon for the reason stated above. In the case that applicant can overcome the above 102(b) rejection, the examiner relies on the following 103(a) rejection. It is the position of the examiner that it would have been prima facie obvious for one of ordinary skill in the art to, by routine experimentation modify Uemura's keratotic plugs remover composition with the expectation of at least similar result, because the reference teaches the advantageous result in the use of nonionic polymer and polymer having sulfonic group for the same purpose, *i.e.*, to remove keratotic plugs in the skin pores.

Claims 14, 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uemura et al., in view of Ishida et al. US 6,221,382.

Uemura is relied upon for the reasons stated above. The reference is silent as to the teaching of keratotic plug remover composition on a sheet or film.

Ishida teaches plug remover composition on a sheet pack of moisture-permeable layer (see abstract). The sheet pack having water content of 0.1 to 30% by weight

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(column 9). Hence, it would have been prima facie obvious for one of ordinary skill in the art to prepare Uemura's composition in a form of sheet pack in view of the teaching of Ishida, because the references teach the use of similar composition for the same purpose, i.e., combination of polymers useful to remove keratotic plugs.

Claims 15, 16, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uemura et al., in view of Ishida et al.

Uemura and Ishida are relied upon for the reasons stated above. The reference is silent as to the teaching of solvent content and flowability be claimed. Absent showing evidence on the contrary, it is the examiner's position that it would have been obvious that the compositions taught by Uemura and Ishida would have similar solvent content since the compositions contain the same polymers in the same ratios as claimed, and using for the same purpose.

Response to Arguments

Applicant's arguments filed 02/12/03 have been fully considered but they are not persuasive. The examiner maintains the original rejections.

Claims 1-13, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Uemura et al. US 5,512,277.

Applicant argues that Uemura does not teach the combination of polymer (A) having sulfonic or sulfate groups or salts thereof and nonionic polymer (B). Contrary to the applicant's argument, Uemura at column 2, lines 12-32 teaches, polymer can be

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styrene sulfonic acid, 2-acrylamide-s-methyl propane sulfonic acid, and the like, which are unsaturated sulfonic acid monomers or their salts; and at column 4, lines 48 through column 5, where Uemura teaches the keratotic plug formulation further comprises polyethylene glycol, polypropylene glycol, polyvinyl alcohols, and the like (nonionic polymer).

Applicant argues that Uemura does not teach combination of a polymer having sulfonic or sulfate groups or salts thereof, with a nonionic polymer, where the polymers are combined in the claimed ratios. Applicant's attention is called to column 3, where Uemura teaches the amount of polymer is from 0.01 to 70%; and at column 5, lines 9-10, wherein the amount of nonionic polymer is from 0.01 to 50%. Thus, the disclosed amounts if converted to ratio, would clearly fall within the claimed ratios. Accordingly, Uemura does teach the combination of polymer (A) and nonionic polymer (B) in the claimed ratios.

Applicant argues that composition 9 of table 6 disclosed a ratio of 80:20, which is outside the claimed ratio. However, Uemura is relied upon for the teachings within the four-wall patent. Uemura cannot be limited to his best mode as described in the examples.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uemura et al. (either alone) or, in view of Ishida et al. US 6,221,382.

Applicant argues that Ishida does not overcome the deficiencies of Uemura, and therefore, there is no suggestion to combine the references. In response to applicant's

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argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It is also noted that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ishida is relied upon solely for the teaching of keratotic plug remover composition, which can be on a sheet.

Applicant argues that the references do not disclose the improvement in keratotic plug removal with increased humidity that results in the present invention. In response to applicant's argument that the references fail to show certain feature of applicant's invention, it is noted that the feature upon which applicant relies (i.e., the improvement in keratotic plug removal with increased humidity that results in the present invention) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is further noted that when the claimed and prior art products are identical or substantially identical in

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structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In this case, Uemura teaches the claimed combination of polymer (A) and nonionic polymer (B) in the same ratios being claimed. Therefore, the property desired by the applicant is clearly obvious.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-

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5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600